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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/148,474	09/08/1998	EIJI TAKASU		3424

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EXAMINER

PAULA, CESAR B.

ART UNIT PAPER NUMBER

2176

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/148,474

Applicant(s)

TAKASU ET AL.

Examiner

CESAR B PAULA

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to the request for CPA filed on 5/28/2002.

**This action is made Non-Final.**

2. In the amendment, claims 1-31 are pending in the case. Claims 1, 10, 14, 26, and 30-31 are independent claims.

3. The rejection of claims 1-31 under 35 U.S.C. 103(a) as being unpatentable over Mosher in view of Forcier (Pat. # 5,590,257, 12/31/96) have been withdrawn as necessitated by the amendment.

#### *Priority*

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 9-243,991 filed in Japan on 9/9/1997, which papers have been placed of record in the file.

#### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mosher in view of Forcier (Pat. # 5,590,257, 12/31/96), further in view of Linking Handwriting Annotation with Text, IBM TDB, vol.32, No.6A, pp.452-454, 11/1989.

Regarding independent claim 1, Mosher discloses: *storing a received mail document* -- “You can save messages .....” (p.1). Mosher fails to explicitly teach *ink data overlaid on a text image*. However, IBM teaches the overlaying of ink over text data (p.1, and fig.1). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the email system of Mosher, and the overlaying of ink data and text data of IBM, because IBM teaches preserving the correspondence between text and ink annotation (p.1,L.10-14).

Moreover, Mosher discloses: inserting a character string to email text data when a new email is prepared -- “Figure 12.9 When you reply to a message....indenting the message text and including header ” (p.4, and 7). Mosher fails to explicitly teach *deriving a shift amount of an output position of the ink image.... and outputting the text image with the inserted character string*. However, IBM teaches the moving text and handwritten together by a predetermined shift amount (p.1, lines 10-29). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the email system of Mosher, and the overlaying of ink data and text data of IBM, because IBM teaches preserving the correspondence between text and ink annotation (p.1,L.10-14).

Regarding claim 2, which depends on claim 1, Mosher discloses: “Figure 12.9 When you reply to a message....indenting the message text and including header ” (p.4). Mosher fails to explicitly teach *the ink data comprises locus information to define the output position by*

*coordinate values*. However, IBM teaches the moving text and handwritten together by a predetermined shift amount (p.1, lines 10-29). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined shifting of email messages by Mosher, and the locus information of ink/ASCII editing system by moving/shifting (locus x-y placement of ink data), and maintaining the pre-existing word spacing in the characters as taught by IBM, because IBM teaches preserving the correspondence between text and ink annotation (p.1,L.10-14).

Regarding claim 3, which depends on claim 1, Mosher discloses: "...how much text of the incoming message to quote ....." (p.3). Mosher fails to explicitly disclose: ....*said character string to be inserted is a quotation symbol*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have included the quotation symbol, because Mosher teaches above, quoting text in a reply email message.

Regarding claim 4, which depends on claim 1, Mosher discloses: "...how much text of the incoming message to quote" (p.3). Mosher fails to explicitly teach *said character string to be inserted is an inserting comment text*. However, Forcier teaches: "performing word editing functions such as word wrap while maintaining the user's word spacing", and "Typical users of the invention would be people who want to jot down notes with/without drawings" (col. 3, lines 3-67, and col. 5, lines 27-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined shifting of email messages by Mosher, and the jotting notes with ink/ASCII editing system to maintain word spacing taught by Forcier, because Forcier teaches above the entering of data into a textual document without having to perform explicit actions to acquire additional blank spaces, and quickly annotating a document.

Claims 5-9 are directed towards a method for implementing the steps found in claim 1, 1, 6, and are similarly rejected.

Claims 10-11 are directed towards a method for implementing the steps found in claims 1-2, and 1 respectively, and are similarly rejected.

Claims 12-15, 17-22 are directed towards an information processing apparatus for implementing the steps found in claims (1-2), 2, and 1-2, and 4-9 respectively, and are similarly rejected.

Claim 16 is directed towards an information processing apparatus for implementing the steps found in claim 3, and is similarly rejected.

Regarding claim 23, which depends on claim 14, Mosher discloses: *output means is an inkjet printer--* (p.9). Mosher teaches use of a print file icon to print the email in a printer such as an inkjet printer.

Claims 24-29 are directed towards an information processing apparatus for implementing the steps found in claims 23, 1, 10-13 respectively, and are similarly rejected.

Claims 30-31 are directed towards a storage medium for storing instructions for implementing the steps found in claims 1, and 10 respectively, and are similarly rejected.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 10, 14, 26, 30-31 have been considered but are moot in view of the new ground(s) of rejection. The Applicants submit that: the cited art alone or in combination fails to teach the limitations of the amended claims (p.13, lines 1-4).

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The Applicants are directed towards the newly crafted rejections above as necessitated by this amendment.

*Conclusion*

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Drews et al (Pat. # 5,831,615), Schilit et al. (Pat. # 6,279,014), **Object Set Positioning Relative to the Page in a Multiple Data Editor, IBM TDB, Vol.27, No.12, pp.7061-7062, 5/1985.** and **Protected Block Selection and Automatic Keep for Graphic Objects in a Multiple Data Editor, IBM TDB, Vol.27, No.10B, pp.6006, 3/1985.**

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

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- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry, **except formal After Final communications**)


Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label “**PROPOSED**” or “**DRAFT**”).

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).**

*CBP*

8/9/02

  
STEPHEN S. HONG  
PRIMARY EXAMINER